

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: MOHAMED, Abdulahi
Serial No.: 09/964,590
Filed: September 28, 2001
Title: Electronic display with multiple pre-programmed messages

Examiner: Shirley Chang
Group Art Unit: 2623
May 16, 2006

**RESPONSE TO NON-FINAL OFFICE ACTION
MAILED May 1, 2006**

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This response is provided in response to a non-final office action mailed on May 1, 2006. Submitted herewith is a Power or Attorney in relation to the above application. Please change the Attorney Docket Number herein to 50035-1.

Remarks/Arguments begin on page 2.

Conclusion and Request for Allowance begins on page 6.

Remarks/Arguments

This response is provided in response to a non-final office action mailed on May 1, 2006.

Rejection of claims under 35 U.S.C. §102(e):

The examiner has rejected claims 1-5, 7, 10 as being anticipated by Wagner (6,236,303). Applicant respectfully submits that these claims are not anticipated by Wagner because Wagner does not describe all of the features of claim 1.

The standard for an anticipation rejection has been well established by the Court of Appeals for the Federal Circuit, as follows:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987).

The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q. 2d 1913 (Fed. Cir. 1989).

For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. ... These elements must be arranged as in the claim under review ... but this is not an 'ipsissimis verbis' test ... *In re Bond*, 15 U.S.P.Q. 2d 1566, 1567 (Fed. Cir. 1990).

In the instant application, claim 1 recites the features of a first processing device for providing display information to said display screen in said first housing, and a second processing device for providing display information to said display screen in said second housing. Furthermore, claim 1 recites a means for conducting electric signals between said first and second processing devices. Accordingly, the device claimed in claim 1 comprises two processing devices that are in communication with each other.

In contrast, Wagner does not teach a device having two processing devices, nor does it teach a devices having two processing devices that are in electrical communication with each other. The feature of a microprocessor in Wagner is briefly mentioned in

the context of one such processor that may be used, for example, to control electronic push button/membrane switches, operation of a plurality of lights, including blinking lights, remote switching and actuation, and a security/alarm feature. Nowhere does Wagner teaches a device having two microprocessors that are in communication with each other.

Accordingly, applicant respectfully submits that Wagner does not identically show every element of the claimed invention of claim 1 in as complete detail as claimed so as to anticipate claim 1. Applicant further submits that the claimed invention of claim 1 would also be patentable over Wagner since there is nothing in Wagner that suggests a device having two microprocessors or the desirability of a device having two microprocessors so as to provide a motivation to persons skilled in the art to alter the device taught in Wagner to that of the device claimed in claim 1.

In regards to dependent claims 2-5, 7, 10, applicant submits that these claims derive patentability from their dependence on patentable claim 1.

Consequently, applicant respectfully submits that claims 1-5, 7, 10 are not anticipated by Wagner and are patentable over Wagner, and the examiner is kindly requested to withdraw her rejection of these claims.

Rejection of claims under 35 U.S.C. §103:

The examiner has rejected dependent claims 6, 8, 9, 11-15 as being unpatentable over Wagner (claims 8, 9) and over Wagner in view of either Bodell (claims 6, 14), Morris (claims 11, 12), Shimizu (claim 13) and Faggiano (claim 15).

In view of the comments presented above in regards to the patentability of claim 1, applicant respectfully submits that dependent claims 6, 8, 9, 11-15 derive patentability from their direct or indirect dependence on patentable claim 1.

Furthermore, applicant makes these additional comments in regards to claims 11 and 12. Applicant submits that a *prima facie* case of obviousness requires that there must be some suggestion or motivation, either in Wagner or in the knowledge generally available to one of ordinary skill in the art, to modify Wagner or to combine Wagner with Morris. As well, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Applicant respectfully submits that there is nothing in Wagner to provide the requisite suggestion or motivation. There is no suggestion in Wagner of wireless communication between the switch assembly and indicator assembly, nor is there a suggestion of the desirability of wireless communication. Rather, Wagner expressly teaches that these assemblies be electrically connected, which necessitates that the structures on which the Wagner device is mounted be modified to accommodate electrical wires running between the switch assembly and the indicator assembly.

When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper (*Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986), and to present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references (*Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)).

In the instant application, the examiner states:

As to claims 11 and 12,

Wagner fails to specifically teach said first and second processing devices are adapted to communicate wirelessly by audio and radio frequency.

Morris discloses a wireless communication between two devices using audio or radio frequency (col. 1, lines 57-60).

It would have been obvious to one of ordinary skill in the art to modify Wagner's system to teach said first and second processing devices are adapted to communicate wirelessly by audio frequency, as taught by Morris, so as to allow two remotely located devices to communicate wirelessly.

In addition to applicant's submission above that Wagner does not teach said first and second processing devices, applicant further respectfully submits that in the above statement, the examiner does not provide an objective and convincing line of reasoning as to why a person of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references since there is no immediately apparent motivation within the references themselves. Applicant further submits that a blanket statement as provided by the examiner to the effect that modifications of the prior art to meet the claimed invention would have been within the ordinary skill of the art at the time the claimed invention was made because the aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). No such reasons are provided, and applicant respectfully submits that a *prima facie* case of obviousness has not been established in regards to claims 11 and 12 for at least the reasons above. Applicant further submits these claims are patentable in any event because of their dependence on patentable claim 1.

Conclusion

The claims pending in the application are claims 1-15. For the foregoing reasons, applicant respectfully submits that this application is in a condition of allowance and accordingly requests the examiner to pass Patent Application Serial No. 09/964,590 to allowance.

Respectfully submitted,



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